



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/989,994

11/20/2001

Qiang Liu

8325-0011.20

1661

20855

7590

05/11/2005

ROBINS & PASTERNAK
1731 EMBARCADERO ROAD
SUITE 230
PALO ALTO, CA 94303

EXAMINER

CARLSON, KAREN C

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,994

Applicant(s)

LIU, QIANG

Examiner

Karen Cochrane Carlson, Ph.D.

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 22, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 2-7, 9-22 and 24-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8, 19 and 23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1653

This Office Action is in response to the Petition of the Restriction Requirement and Response to the Action on the Merits filed July 22, 2004. The petition to switch inventions was denied in the Petition Decision mailed April 15, 2005.

Applicant's election with traverse of a zinc finger protein comprising F1 sequence DRSNLTR, F2 sequence TSGHLSR, and F3 sequence RSDHLSR in the paper filed January 16, 2004 is acknowledged.

The requirement is still deemed proper and is therefore again made FINAL.

Claims 1, 8, 19, and 23 are under examination. Claims 2-7, 9-18, 19-22, and 24-49 have been withdrawn from further examination by the Examiner because these claims are drawn to non-elected inventions.

Priority is set to the filing date, November 20, 2001. The elected invention (January 16, 2004) wherein F1 sequence DRSNLTR, F2 sequence TSGHLSR, and F3 sequence RSDHLSR is found N- to C- terminal in a zinc finger protein is not found in:

09/535,088, filed March 23, 2000 or

09/716,637, filed November 20, 2000 or

60/146,615, filed July 30, 1999

60/146,595, filed July 30, 1999 or

60/126,239, filed March 24, 1999 or

60/126,238, filed March 24, 1999.

Thus, reference to these applications for priority should be deleted from the file.

In the Petition of the Restriction Requirement and Response to the Action on the Merits filed July 22, 2004 Applicants attempted to switch their invention to F1= RSDNLAR, F2= RSDNLAR, and F3 RSDNLTR. As noted in the Petition Decision mailed April 15, 2005, the restriction

Art Unit: 1653

requirement was found to be proper and is therefore maintained. Applicants arguments against the rejection made in the Office Action mailed March 18, 2004 as found on page 11-12 of the Petition is that the restriction is improper and that the references do not teach their invention if they are permitted to shift their invention to F1= RSDNLAR, F2= RSDNLAR, and F3 RSDNLTR.

Applicants are not permitted to shift their invention, and therefore the following rejections are being maintained.

Maintenance of Rejections:

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1, 8, 19, and 23 are again provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 5 of copending Application No. 10/006,069. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 5 of '069 lists VOP 32-E having a F1 sequence DRSNLTR, F2 sequence TSGHLSR, and F3 sequence RSDHLSR. VOP 32-E binds to target 5' - GGG GGT GAC - 3', thus when S1 comprises GAC, F1 is sequence DRSNLTR, when S2 comprises GGT, F2 is sequence TSGHLSR, and when S3 is GGG, F3 is sequence RSDHLSR. See Table 3 of '069.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 1653

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 8, 19, and 23 are again provisionally rejected under the judicially created doctrine of double patenting over claim 1-4, 6-18, and 91-93 of copending Application No. 10/006,069. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: VOP 32-E

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is again rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 recites non-elected subject matter and therefore does not particularly point out and distinctly claim the subject matter which applicant regards as the elected invention.

Art Unit: 1653

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 8, 19, and 23 are again rejected under 35 U.S.C. 102(e) as being anticipated by Rebar et al. (2002; WO 02/46412, filed December 6, 2001, the instant sequence found in priority application 09/846,033 filed April 30, 2001) The applied reference has 3 common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Rebar et al. disclose a variety of zinc finger proteins said to regulate VEGF expression. At page 103, Table 3, zinc finger protein (ZFP) designated VOP 32-E having a F1 sequence DRSNLTR, F2 sequence TSGHLSR, and F3 sequence RSDHLSR. VOP 32-E binds to target 5' - GGG GGT GAC – 3', thus when S1 comprises GAC, F1 is sequence DRSNLTR, when S2 comprises GGT, F2 is sequence TSGHLSR, and when S3 is GGG, F3 is sequence RSDHLSR.

WO 02/46412 is a very large application. Therefore, only pertinent pages to this rejection are being sent: Front page and pages 101-107. Because the inventors overlap, it is assumed that Applicants have a copy of the WO document.

Art Unit: 1653

Claims 1, 8, 19, and 23 are again rejected under 35 U.S.C. 102(e) as being anticipated by Rebar et al. (US 2003/0021776, published January 30, 2003, from SN 10/006,069, priority for elected invention in 09/846,033, filed April 20, 2001)

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Rebar et al. disclose a variety of zinc finger proteins said to regulate VEGF expression. In Table 3, zinc finger protein (ZFP) designated VOP 32-E having a F1 sequence DRSNLTR, F2 sequence TSGHLSR, and F3 sequence RSDHLSR. VOP 32-E binds to target 5' - GGG GGT GAC - 3', thus when S1 comprises GAC, F1 is sequence DRSNLTR, when S2 comprises GGT, F2 is sequence TSGHLSR, and when S3 is GGG, F3 is sequence RSDHLSR. See Claim 5 for the specific claiming of VOP 32-E.

US 2003/0021776, published January 30, 2003, from SN 10/006,069 is a very large application. Therefore, only pertinent pages of this application are being sent: Front page, Tables 3 and 4, and the claims. Because the inventors overlap, it is assumed that Applicants have a copy of this document.

No Claims are allowed.

Art Unit: 1653

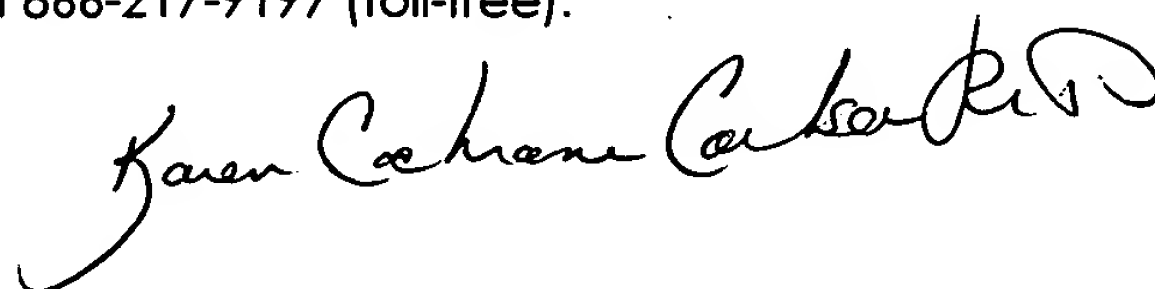
THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Cochrane Carlson, Ph.D. whose telephone number is 571-272-0946. The examiner can normally be reached on 7:00 AM - 4:00 PM, off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Jon Weber can be reached on 571-272-0925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER